

**REMARKS**

Claims 4 and 5 are pending in this application.

Applicant has proposed herein to amend claim 4. The proposed changes to claim 4 would not introduce any new matter.

Applicant respectfully requests reconsideration of the rejection of claims 4 and 5 under 35 U.S.C. § 103(a) as being unpatentable over *Arthur et al.* (U.S. Patent No. 5,049,898) in view of *Sakamoto et al.* (U.S. Patent No. 5,719,686) and *Skene et al.* (U.S. Patent No. US 6,616,260 B2). As will be explained in more detail below, the combination of *Arthur et al.* in view of *Sakamoto et al.* and *Skene et al.* is improper because a suggestion in the prior art to combine the references to obtain the subject matter defined in independent claim 4, as proposed herein, is lacking.

Applicant maintains the position that the cartridge of *Arthur et al.* is configured to be vertically detached from the printer, as set forth in the Amendment filed on September 23, 2005 (and received in the PTO on October 3, 2005). Nevertheless, in an effort to expedite prosecution of this application and to distinguish the claimed subject matter from that shown in the *Arthur et al.* reference, Applicant has proposed herein to amend claim 4 to specify that terminals of the memory devices are always connected to terminals of the printer when the print recording material reservoirs are mounted on the printer (support for the proposed changes to claim 4 can be found in Paragraphs 44 and 45 of Applicant's specification).

According to the Examiner, the cartridge of *Arthur et al.* cannot be physically removed from the printer when its memory is being accessed by the reading device. As such, the cartridge shown by *Arthur et al.* does not need to have the configuration specified in claim 4 because the primary purpose of such configuration is to determine whether or not communication is possible when the cartridge is in a position from which it cannot be

removed. Thus, there would have been no motivation for one having ordinary skill in the art to provide the cartridge of *Arthur et al.* with the configuration specified in claim 4.

Further, the ink cartridge shown by *Arthur et al.* must be properly placed in the carriage in the first place; otherwise, reading is not possible. As a result, there would have been no need for *Arthur et al.* to perform the claimed step of determining whether or not an ink cartridge is mounted. Moreover, as claim 4 specifies that the terminals of the memory devices are always connected to terminals of the printer when the print recording material reservoirs are mounted on the printer, there would not have been any motivation for one having ordinary skill in the art to modify the device of *Arthur et al.* in the manner proposed by the Examiner. On the other hand, in the case of the claimed subject matter, even if an ink cartridge is mounted on a carriage, sometimes communication is not possible, e.g., because the cartridge is not mounted in the proper manner.

In summary, for the reasons discussed above, there would have been no motivation for one having ordinary skill in the art to modify the device of *Arthur et al.* to obtain the subject matter defined in claim 4. As such, the requisite suggestion in the prior art to combine the *Arthur et al.*, *Sakamoto et al.* and *Skene et al.* references in the manner proposed by the Examiner is lacking. Accordingly, claim 4, as proposed herein, is patentable under 35 U.S.C. § 103(a) over the combination of *Arthur et al.* in view of *Sakamoto et al.* and *Skene et al.* Claim 5, which depends from claim 4, is likewise patentable under 35 U.S.C. § 103(a) over the combination of *Arthur et al.* in view of *Sakamoto et al.* and *Skene et al.* for at least the same reasons set forth above regarding claim 4.

Applicant respectfully requests that the amendment proposed herein be entered. The proposed amendment responds to the Examiner's rebuttal of Applicant's arguments regarding the vertical removal of the ink cartridge of *Arthur et al.*, and could not have been presented earlier because the Examiner's rebuttal was presented for the first time in the Final Office

Action. Moreover, the proposed amendment does not raise any new issues or require any additional search. Accordingly, Applicant respectfully submits that the proposed amendment complies with the requirements of 37 C.F.R. § 1.116(b) and should be entered.

In view of the foregoing, Applicant respectfully requests reconsideration and reexamination of claims 4 and 5, as proposed herein, and submits that these claims are in condition for allowance. Accordingly, a notice of allowance is respectfully requested. In the event a telephone conversation would expedite the prosecution of this application, the Examiner may reach the undersigned at (408) 749-6902. If any fees are due in connection with the filing of this paper, then the Commissioner is authorized to charge such fees to Deposit Account No. 50-0805 (Order No. MIPFP018A).

Respectfully submitted,  
MARTINE PENILLA & GENCARELLA, L.L.P.

A handwritten signature in black ink, appearing to read 'Peter B. Martine', with a long horizontal line extending to the right.

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